The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHANDA DHARAP

Appeal No. 2004-1148
Application No. 09/374,694

ON BRIEF

Before RUGGIERO, GROSS, and SAADAT, ***Administrative Patent Judges***.

GROSS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 20, which are all of the claims pending in this application.

Appellant's invention relates to a method of processing an information resource including caching a copy of the information resource in dependence upon a semantic type associated with the information resource. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method of processing an information resource, the method comprising:

receiving a copy of the information resource from a remote source, and

caching the copy of the information resource in dependence upon a semantic type associated with the information resource.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Rubin et al. (Rubin) 6,061,763 May 09, 2000

Appellant's admitted prior art at pages 1-4 of the specification (AAPA)

Claims 1 through 20 stand rejected under 35 U.S.C. § 102(a) as being anticipated by AAPA.

Claims 1 through 5, 7, 8, 10, and 12 through 17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Rubin.

Claims 6, 9, 11, and 18 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rubin.

Reference is made to the Examiner's Answer (Paper No. 13, mailed November 26, 2002) for the examiner's complete reasoning in support of the rejections, and to appellant's Brief (Paper No. 12, filed September 13, 2002) for appellant's arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellant and the examiner. As a consequence of our review, we

will reverse the anticipation rejection of claims 1 through 20 over AAPA as well as the anticipation rejection of claims 1 through 5, 7, 8, 10, and 12 through 17 and the obviousness rejection of claims 6, 9, 11, and 18 through 20 over Rubin.

Each of the independent claims recites caching or processing a resource copy in dependence upon a semantic type associated with the information resource. As stated by the examiner (Answer, page 7), "[t]he primary disagreement is what is meant by the term 'semantic type.'" The examiner continues (Answer, page 8) that "where a claimed phrase is unclear, one may refer to the specification to give life and meaning to the claimed phrase. In the instant case, however, the phrase 'semantic type' is not unclear." The examiner thereby defines "semantic type" as "data type." The examiner further states (Answer, page 12) that "equating 'semantic type' with arbitrary volatility actually gives a meaning to the words 'semantic type' that is repugnant to their ordinary meaning and contradictory to the examples in the specification and is therefore not allowed."

We first note that the examples in the specification all relate to the volatility perceived by a user and, therefore, a definition of "arbitrary volatility" is not contrary to the examples. Also, the examiner should realize that:

> The written description must also be examined, because it is relevant to aid in the claim construction analysis, e.g., to determine if the presumption of ordinary and customary meaning is rebutted. *See Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 [48 USPQ2d 1117] (Fed. Cir. 1998). The presumption will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth a definition of the term different from its ordinary and customary meaning. *See In re Paulsen*, 30 F.3d 1475, 1480 [31 USPQ2d 1671] (Fed. Cir. 1994); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88 [21 USPQ2d 1383] (Fed. Cir. 1992). . . . *See Teleflex*, 299 F.3d at 1324.

ACTV Inc. v. Walt Disney Co., 346 F.3d 1082, 1090-91, 68 USPQ2d 1516, 1523 (Fed. Cir. 2003).

> While limitations in the specification must not be routinely imported into the claims because a patentee need not describe all embodiments of his invention, *see Rexnord*, 274 F.3d at 1344, a definition of a claim term in the specification will prevail over a term's ordinary meaning if the patentee has acted as his own lexicographer and clearly set forth a different definition, *see Tex. Digital Sys.*, 308 F.3d at 1204 (noting that 'the inconsistent dictionary definition must be rejected' if the specification rebuts the presumption of ordinary and customary meaning); *Rexnord*, 274 F.3d at 1342.

3M Innovative Properties Co. v. Avery Dennison Corp., 350 F.3d 1365, 1371, 69 USPQ2d 1050, 1054 (Fed. Cir. 2003).

Appellant clearly defines "semantic type" in the specification (page 3) as "the different connotative meanings that the information contents of resources can have, as perceived by the user." This definition requires that the different

connotative meanings the content can have are "as perceived by the user." In other words, the different meanings may vary from one user to the next or even from one time to the next for the same user.

The examiner asserts (Answer, page 4) that the AAPA discloses caching the copy of information "in dependence upon a semantic type associated with the resource (whether it is an image or text)." The examiner has equated semantic type with whether a resource is image or text. Appellant does state that the resource is cached based on a prediction of whether the resource is likely to have changed. However, appellant implies that the prediction is substantially fixed and not subject to a user's perception. Appellant gives as an example, an image being expected to change less often than text. The implication is that an image basically always changes less often than text, regardless of the user. In other words, the "connotative meanings" are essentially fixed. Therefore, the AAPA fails to meet appellant's "semantic type" wherein the different connotative meanings that the resources can have are as perceived by the user. Accordingly, we cannot sustain the anticipation rejection of claims 1 through 20 over the AAPA.

The examiner (Answer, page 5) further rejects claims 1 through 5, 7, 8, 10, and 12 through 17 under 35 U.S.C. § 102(e) over Rubin. The examiner contends (Answer, page 6) that Rubin caches the copy of an information resource "in dependence upon a semantic type (predefined or predetermined criteria) associated with the resource."

Rubin discloses (column 2, lines 38-42) that the predefined or predetermined criteria "may be any of many possible limitations specified by a user or system developer. For example, the predefined criteria may require that data objects pertain to particular subject matter." An example given by Rubin (column 8, lines 32-36) is that a buffer cache may be reserved for data records relating to employees of an organization. Rubin discloses (column 8, lines 63-65) that the user "binds objects meeting predefined criteria . . . to particular buffer caches." Thus, the caches are determined by fixed criteria, not by anything perceived by the user. Therefore, Rubin, like the AAPA, fails to disclose caching or processing a resource copy in dependence upon a semantic type associated with the information resource. Accordingly, we cannot sustain the anticipation rejection of claims 1 through 5, 7, 8, 10, and 12 through 17 over Rubin.

Regarding claims 6, 9, 11, and 18 through 20, the examiner has presented no further evidence or reasoning as to why it would have been obvious to the skilled artisan to modify Rubin to base the criteria for caching on a semantic type associated with the information resource. Therefore, we cannot sustain the obviousness rejection of claims 6, 9, 11, and 18 through 20.

CONCLUSION

The decision of the examiner rejecting claims 1 through 20 under 35 U.S.C. § 102(a) over AAPA, claims 1 through 5, 7, 8, 10, and 12 through 17 under 35 U.S.C. § 102(e) over Rubin, and claims 6, 9, 11, and 18 through 20 under 35 U.S.C. § 103 over Rubin is reversed.

REVERSED

JOSEPH F. RUGGIERO Administrative Patent Judge	)	
ANITA PELLMAN GROSS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MAHSHID D. SAADAT Administrative Patent Judge	)	

APG:clm

CORPORATE PATENT COUNSEL
U.S. PHILIPS CORPORATION
580 WHITE PLAINS ROAD
TARRYTOWN, NY 10591